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10/790,968	03/02/2004	David L. Kaminsky	RSW920040009US1	2144

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EXAMINER

MANOHARAN, MUTHUSWAMY GANAPATHY

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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12/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/790,968

Applicant(s)

KAMINSKY ET AL.

Examiner

Muthuswamy G. Manoharan

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/10/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-18 and 20-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-18 and 20-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/10/2007 has been entered.

Claim Objections

Claims 1, 15 and 29 are objected to because of the following informalities:

Claims recite the phrase, "computer readable storage readable medium" which requires correction in order to interpret the meaning correctly.

Appropriate correction requested.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1,4,6,8,11,15,18,20,22,25,30 and 32 are rejected under 35

U.S.C. 102(a) as being anticipated by Karlsson (US 2005/0221808).

Regarding claim 1, Karlsson teaches a method comprising:

A telephone having a computer readable storage readable medium and an input device connected to a processor (Abstract, Figure 6)

A first program and second program in the computer readable medium (note: programmable device includes a processor and storage (Figure 6); wherein the first program comprises instructions for the processor to perform steps comprising (Figure 1): responsive to plurality of user actions at the input device defining plurality of policies wherein the second program to perform the steps (Figures 2-4; Paragraph [0025]):

Detecting an incoming telephone call received by the telephone ("triggering event", "forward calls to voice mail", "altering device ringing behavior", this requires detection of incoming call; Paragraph [0009])

determining a plurality of conditions associated with a telephone ("enabling user defined one or more criteria", Paragraph [0006]);

comparing a plurality of conditions to a plurality of policies (Figure 1), each policy comprising a plurality of condition criteria and a telephone behavior instruction (Figures 2-4);

identifying a single policy within the policies, the single policy containing the condition criteria corresponding to the conditions (Paragraphs [0022-0024,0042-0044]);

adjusting a telephone behavior according to the telephone behavior instruction for the single policy wherein the telephone behavior is an action that the telephone takes in response to the reception of the incoming call ("alter its behavior when the user defined criteria are satisfied", Paragraph [0017]; Trigger event could be an incoming phone call; "automatically sends a SMS text message", Paragraph [0008]);

wherein the action comprises a plurality of telephone behaviors ("non-ringing" , Paragraph [0004], "diverting calls to voice mail", Paragraph [0009]);

wherein the action is accomplished without a mode change control unit, a mode selection button, or a separation of an ambient sound into a speech component and a non-speech component (Paragraphs [0001-0057]);

and wherein the telephone is a wireless telephone ("wireless information device", Paragraph [0002]).

Regarding **claim 4**, Karlsson further teaches the apparatus of claim 1 further comprising: the telephone; and wherein the computer readable storage medium is a memory within the telephone (Figure 6).

Regarding **claim 6**, Karlsson further teaches the apparatus of claim 1 wherein one of the condition criteria is a location criterion; and wherein the location of the telephone is determined using a GPS network ("criteria defining logical location", Paragraph [0006], "GPS", Paragraph [0008]).

Regarding **claim 8**, Karlsson further teaches the apparatus of claim 6 wherein one of the condition criteria is a context criterion and wherein the context is determined by accessing a PDA program stored on the telephone ((Figures 1 and 2).

Regarding **claim 11**, Karlsson further teaches the apparatus of claim 6 wherein the condition criteria comprise a location criterion and a context criterion (Figures 2-5).

Claims 18, 20, 22 and 25 are rejected for the same reason as set forth in claims 4, 6, 8 and 11 respectively.

Claims 15 and 29 are rejected for the same reason as set forth in claim 1.

Claims 30 and 32 are rejected for the same reason as set forth in claims 2 and 4 respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2,3,7,9,10,12-14,16-17,21,23-24,26-28,31 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karlsson et al. (hereinafter Karlsson) (US 2005/0221808) in view of Erb (US 2004/0142703).

Regarding **claim 2**, Karlsson teaches all the particulars of the claim except wherein the policies further comprise: a policy priority number and wherein the policy priority number resolves any outcome conflicts between the policies. However, Erb

teaches in an analogous art wherein the policies further comprise: a policy priority number and wherein the policy priority number resolves any outcome conflicts between the policies ("importance Threshold", Figure 4). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use the method to have a a policy priority number and wherein the policy priority number resolves any outcome conflicts between the policies in order to control the behavior of the telephone so that incoming calls do not take priority over the assigned events.

Regarding **claim 3**, Erb further teaches the apparatus of claim 1 wherein the policies are stored in a policy table according to the policy priority number (Figure 4; Paragraph [0033], lines 1-3).

Regarding **claim 7**, Erb further teaches the apparatus of claim 6 wherein one of the condition criteria is a location criterion; and wherein the location of the telephone is determined using triangulation (Paragraph [0010], lines 10-12).

Regarding **claim 9**, Erb further teaches the apparatus of claim 6 wherein one of the condition criteria is a caller criterion; and wherein the caller identity is determined by analyzing the caller ID data associated with the incoming telephone call (Paragraph [0032], lines 3-7).

Regarding **claim 10**, Erb further teaches the apparatus of claim 6 wherein one of the condition criteria is a caller criterion (Paragraph [0032], lines 4-6); and wherein the caller identity is determined by analyzing the caller ID data associated with the incoming telephone call (Paragraph [0032], lines 4-5) and accessing a PDA program stored on the telephone (paragraph [0032], line 7).

Regarding **claim 12**, Erb further teaches the apparatus of claim 6 wherein the condition criteria comprise a location criterion and a caller criterion (Figure 7; Figure 4; Paragraphs [31-33]).

Regarding **claim 13**, Karlsson further teaches the apparatus of claim 6 wherein the condition criteria comprise context criterion (Figures 2-5). Karlsson did not teach specifically caller criterion. However, Erb teaches a caller criterion (Paragraph [0032]). He also teaches condition criteria involving more than one criterion (context and location, Paragraph [0040]; caller and location, Paragraphs [31-33]). Therefore, it would be obvious to one of ordinary skill in the art to use the condition wherein the condition criteria comprise context criterion, and a caller criterion. This modification gives additional flexibility to the user of the telephone.

Regarding **claim 14**, Karlsson teaches a location criterion and a context criterion (Figures 2-5). Karlsson did not teach specifically caller criterion.

However, Erb further teaches the apparatus of claim 6 wherein the condition criteria comprise a location criterion, and a caller criterion (Paragraph [0031-0033]). Erb did not teach specifically the condition criteria comprise a location criterion, a context criterion, and a caller criterion. However, Erb teaches in another embodiment, the apparatus of claim 6 wherein the condition criteria comprise a location criterion, and a context criterion (Paragraph [0040], lines 1-9). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use the condition criteria comprise a location criterion, a context criterion, and a caller criterion. This modification gives additional flexibility to the user of the telephone.

Claim 16 is rejected for the same reasons as set forth in the claim 2.

Regarding **claim 17**, Erb further teaches the method of claim 15 wherein the policies further comprises: a policy priority number ("importance threshold", Figure 4); and wherein the policies are stored in a policy table according to the policy priority number (Figure 4; Paragraph [0033], lines 1-3).

Claims 21, 23, 24, 26, 27 and 28 are rejected for the same reasons as set forth in claims 7, 9, 10, 12-14 respectively.

Claims 31, 33 and 34 are rejected for the same reason as set forth in claims 7, 9 and 10 respectively.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Muthuswamy G. Manoharan whose telephone number is 571-272-5515. The examiner can normally be reached on 7:00AM-2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eng George can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


GEORGE ENG
SUPERVISORY PATENT EXAMINER